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09/583,502	05/31/2000	Jyoti Das	6175-10	4242

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200 PARK AVENUE  
NEW YORK, NY 10166

EXAMINER
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THANGAVELU, KANDASAMY

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 01/12/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Pre

# Office Action Summary

Application No.

09/583,502

Applicant(s)

DAS, JYOTI

Examiner

Kandasamy Thangavelu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003 and 02 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 12-19, 22, 24-31 and 34 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 11, 20, 21, 23, 32, 33 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2000 and 06 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to the Applicants' Response mailed on November 6, 2003 and December 2, 2003. Claims 1-36 were amended. Claims 1-36 of the application are pending. This office action is made final.

### ***Response to Arguments***

2. Applicant's amendments filed on November 6, 2003 and December 2, 2003 have been fully considered together with the Petition to correct Inventorship filed under 37 CFR 1.48 (a) and the declaration of the inventors under 37 CFR 1.131(A) swearing back the primary reference used. The Petition to correct Inventorship filed under 37 CFR 1.48 (a) is not granted as explained in Paragraph 3 below. The Declaration of the inventors under 37 CFR 1.131(A) is not accepted due to insufficient evidence of conception and reduction to practice before the reference date, as explained in Paragraph 4 below. The amended claims 1-36 are rejected using the previously used references.

### ***Petition to correct Inventorship not granted***

3. The Petition to correct Inventorship filed on November 6, 2003 under 37 CFR 1.48 (a) has been fully considered. The Petition to correct Inventorship filed under 37 CFR 1.48 (a) should be accompanied by five items as specified by MPEP 201.03 37 CFR 1.48 (a). One of the requirements is that the request to

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correct the inventorship should be accompanied by the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

MPEP 201.03 37 CFR 1.48 (a) D specifies that a written consent of every existing assignee of the original named inventors must be submitted. It also specifies that the assignee should give its consent to the requested inventorship correction and the individual signing on behalf of the assignee giving its consent to the requested inventorship correction should specifically state that he or she has the authority to act on behalf of the assignee.

While the applicant has sent a statement under 37 CFR 3.73(b), the applicant has not produced a statement from the assignee giving its consent to the requested inventorship correction. Therefore, the request for correction of inventorship under 37 CFR 1.48 (a) is not granted. The examiner has maintained the originally named inventor as the sole inventor of the application.

***Affidavit under 37 CFR 1.131 Insufficient***

4. The declaration filed on November 6, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Fujieda (U.S. Patent 6,557,002) reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Fujieda (U.S. Patent 6,557,002) reference.

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The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Fujieda (U.S. Patent 6,557,002) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Fujieda (U.S. Patent 6,557,002) reference to either a constructive reduction to practice or an actual reduction to practice.

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Fujieda (U.S. Patent 6,557,002) reference.

The applicant has not produced any satisfactory evidence of the fact as required by MPEP 715.07.

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

(A) attached sketches;

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- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905);
- (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309

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(Comm'r Pat. 1890) the court stated, if the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

### ***Drawings***

5. The corrections to drawings filed on November 6, 2003 are accepted.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1-4, 7, 10, 12-16, 19, 22, 25-28, 31, 34 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by **Fujieda et al. (FU)** (U.S. Patent 6,557,002).

7.1 **FU** teaches Data management system for storing structural element data management program. Specifically, as per Claim 1, **FU** teaches a computer implemented method for restructuring a design model generated by a computer aided design system (Fig. 1; CL1, L15-18); the method comprising:

receiving at a computer a command to restructure the design model, the design model comprising a first hierarchical data structure interrelating a plurality of components (Fig. 1, Item 14; Fig. 6, Item 61) and the command to restructure comprising a command to change a hierarchical relationship of a first subset of the plurality of components with respect to other ones of the plurality of components (Fig. 1, Item 14; Fig. 6, Item 61; CL3, L28-30);



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in accordance with the command to restructure, generating a new hierarchical data structure comprising a new hierarchical relationship between the plurality of model components (Fig. 1, Item 14; Fig. 6, Item 61; Fig. 9, Item 61; Fig. 10; CL2, L67 to CL3, L2);

determining other relationships between components in the first hierarchical data structure to change as a result of the command to restructure (Fig. 9; Fig. 10; CL3, L46-51); and

dynamically updating the other relationships to preserve the other relationships subsequent to the generation of the new hierarchical relationship (Fig. 9; Fig. 10; CL3, L54-63).

7.2 As per Claim 2, **FU** teaches the method of Claim 1. **FU** also teaches that the first hierarchical data structure comprises a plurality of parent-child relationships relating the plurality of components to a common root component, the parent-child relationships detailing a construction of the design model (Fig. 6, Item 61; CL3, L28-30).

7.3 As per Claim 3, **FU** teaches the method of Claim 2. **FU** also teaches that generating the new hierarchical data structure comprises changing a first hierarchical path between the first subset of the plurality of components and the root component (Fig. 9, Item 61, LX-277B).

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7.4 As per Claim 4, **FU** teaches the method of Claim 3. **FU** also teaches that the other ones of the plurality of components comprises a first other component (Fig. 9, Item 61, LX-277A);

the other relationships comprise a first other relationship between one of the first subset of components and the first other component (Fig. 9, Item 61, LX-277B to LX-277A); and

a second hierarchical path between the root component and the first other component is not changed as a result of the command to restructure (Fig. 9, Item 61, LX-277A).

7.5 As per Claim 7, **FU** teaches the method of Claim 4. **FU** also teaches that the first other relationship comprises an update relationship and dynamically updating the other relationships comprises updating data to maintain the update relationship between the one of the first subset of the plurality of components and the first other component (Fig. 9, Item 61).

7.6 As per Claim 10, **FU** teaches the method of Claim 1. **FU** also teaches that generating the new hierarchical data structure comprises generating a component list identifying a component moving to a new location (Fig. 9, Items 61 and 62); and

updating the other relationships comprises generating a reference list identifying the other relationships to change (Fig. 9, Item 62).

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7.7 As per Claim 12, FU teaches the method of Claim 1. FU also teaches that the first subset of the plurality of components comprise a subassembly of the model (Fig. 6, Item 61, LX-277B).

7.8 As per Claims 13-16, 19, 22, 25-28, 31, 34 and 36, these are rejected based on the same reasoning as Claims 1-4, 7, 10 and 12, as shown above. Claims 13-16, 19, 22, 25-28, 31, 34 and 36 are computer program on a computer readable medium and computer aided design system claims reciting the same limitations as Claims 1-4, 7, 10 and 12, as taught throughout by FU.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 5, 6, 17, 18, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fujieda et al. (FU)** (U.S. Patent 6,557,002) in view of **Altidis (AL)** (Solidworks 98Plus, Design News, April 1999).

10.1 As per Claim 5, **FU** teaches the method of Claim 4. **FU** does not expressly teach that the first other relationship comprises a mate relationship and dynamically updating the other relationships comprises updating data to maintain the first other relationship between the one of the subset of components and the first other component. **AL** teaches that the first other relationship comprises a mate relationship and dynamically updating the other relationships comprises updating data to maintain the first other relationship between the one of the subset of components and the first other component (Col 1, Para 3), as an assembly is put together by specifying ahead of time, how the features of two parts are aligned or mated (Col 1, Para 3). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the method of **FU** with the method of **AL** that included the first other relationship comprising a mate relationship and dynamically updating the other relationships comprising updating data to maintain the first other relationship between the one of the subset of components and the first other component, as an assembly would be put together by specifying ahead of time, how the features of two parts were aligned or mated.

10.2 As per Claim 6, **FU** and **AL** teach the method of Claim 5. **FU** also teaches that prior to the receiving the command to restructure, the first subset of the plurality of

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components is a descendent of the first other component, and subsequent to the restructure, the first subset of the plurality of components is not a descendent of the first other component (Fig. 6, Item 61, LX-277B and Fig. 9, Item 61, LX-277E).

10.3 As per Claims 17, 18, 29 and 30, these are rejected based on the same reasoning as Claims 5 and 6, as shown above. Claims 17, 18, 29 and 30 are computer program on a computer readable medium and computer aided design system claims reciting the same limitations as Claims 5 and 6, as taught throughout by **FU** and **AL**.

***Allowable Subject Matter***

11. Claims 8, 9, 11, 20, 21, 23, 32, 33 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

***ACTION IS FINAL***

12. The Declaration of the inventors under 37 CFR 1.131(A) is not accepted due to insufficient evidence of conception and reduction to practice before the reference date. Therefore, the amended claims 1-36 are rejected using the previously used references. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kandasamy Thangavelu whose telephone number is 703-305-0043. The examiner can normally be reached on Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska, can be reached on (703) 305-9704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

K. Thangavelu  
Art Unit 2123  
January 5, 2004



**SAMUEL BRODA, ESQ.**  
**PRIMARY EXAMINER**